UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,934	01/04/2001	Elliot Cooperstone	37728-6048	3860

		EXAMINER
7590	12/07/2004	OUELLETTE, JONATHAN P

Eileen A Lehmann
Fenwick & West LLP
Two Palo Alto Square
Palo Alto, CA 94306

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
	Office Action Summary	09/755,934	COOPERSTONE ET AL.
		Examiner	Art Unit
		Jonathan Ouellette	3629

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _05 November 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _9-13,17-42 and 51_ is/are pending in the application.

   4a) Of the above claim(s) _1-8 and 43-50_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _9-13,17-42 and 51_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _12/19/2002_.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Applicant's election with traverse of Claims 9-42 and 51 received 11/5/2004 is

acknowledged. The traversal is on the ground(s) that separate status in the art has not

been established, and that searching the claims together would not place any serious

burden on the Examiner. This is not found persuasive because the examiner clearly

explained how each Group (I and II) contained a unique inventive concept, and would

thus require a separate field of search for each group.

The requirement is still deemed proper and is therefore made FINAL.

Response to Amendment

2.   Claims 14-16 have been cancelled, Claims 43-51 have been added, and Claims 1-

8 and 43-50 have been withdrawn; therefore, Claims 9-13, 17-42, and 51 are currently

pending in application 09/885,296.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

4.   <u>Claims 9-42 and 51</u> are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kahn et al. (US 6,401,079).

5.   As per **independent Claims 9 and 21,** Kahn discloses a method of integrating a

plurality of human resource and employee benefit products, some of said products

comprising a source of data, said method comprising: (a) receiving a request from a

requestor to conduct an operation on said data of said plurality of products; (b)

conducting said operation on a shared data source (C13 L43-57, C26 L32-36); (c)

initiating a plurality of tasks to perform said operation for each of the plurality of

products; determining which of said plurality of tasks are critical and creating a sorted

first list of all said tasks initiated to perform said operation on the plurality of products

that are determined to be critical (common rules for queuing operation system

commands); (e) synchronously executing said tasks from said first list, wherein on said

task is being executed at a time in order of priority, with a subsequent task waiting for a

previous task to complete (common rules for queuing operation system commands); (f)

determining which of said plurality of tasks are not critical and creating a second list of

all said tasks initiated to perform said operation on the plurality of products that are

determined to be non-critical (common rules for queuing operation system commands);

and (g) executing said tasks from said second list in asynchronous order (Abstract, Fig.5,

Figs.12(a)-15(e), Figs. 26-34(b), C5 L1-12, C5 L51-61, C13 L43-57, C26 L32-36, C52

39-62).

6.   Kahn fails to expressly disclose wherein at least two of said products format said

sources of data differently, and wherein same data regarding said operation to be

performed is formatted to accommodate different formatting of each of said data source

belonging to the plurality of products.

7.   However, Kahn does disclose seamlessly integrating employer data and third-

party data to provide benefit information to system users (C52 L36-53).

8.   Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have included wherein at least two of said products

format said sources of data differently, and wherein same data regarding said operation to

be performed is formatted to accommodate different formatting of each of said data

source belonging to the plurality of products, in the system disclosed by Kahn, for the

advantage of providing a method of integrating a plurality of human resource and

employee benefit products, with the ability to increase system efficiency by integrating

information from a plurality of sources to provide users with the most current/reliable

information.

9.   As per Claims 10 and 22, Kahn discloses a step of initiating security lookup to

determine whether said request to conduct said operation is authorized and whether all of

said plurality of products are available to the requestor.

10.   As per Claims 11 and 23, Kahn discloses wherein if any one of said

synchronously executed tasks is not successfully completed all said synchronously

executed tasks are rolled back.

11.   As per Claims 12 and 24, Kahn discloses wherein said tasks from said second list

are executed by queuing and scheduling execution according to requirements of the

products that are determined to be non-critical and executing said tasks at a scheduled

time.

12.   As per Claims 13 and 25, Kahn discloses wherein said request to conduct said

operation on said data of said plurality of products is issued by a triggering event, said

triggering event comprising one or more events from among events in lives of employees,

calendar events, and predetermined events.

13.   As per **independent Claim 17,** Kahn discloses a network site comprising a

computer server that provides display pages to requesting client machines, the network

site further comprising: (a) a first set of human resource and employee benefit products

installed at the computer server and accessed by a client machine; and (b) one or more

network links from the computer server to computer servers of corresponding third party

providers, each of whom offers one or more human resource and employee benefit

products that are accessed from a client machine by the network link, therein comprising

a second set of human resource and employee benefits products, wherein the computer

server receives requests from client users for services from the first and second set of

human resource and the employee benefit products, and responds by determining the

appropriate application to process the client user request, therein comprising an integrated

benefits package accessed by the client machines(Abstract, Fig.5, Figs.12(a)-15(e), Figs.

26-34(b), C5 L1-12, C5 L51-61, C13 L43-57, C26 L32-36, C52 39-62).

14.   Kahn fails to expressly disclose wherein the third party providers are bound to a

determined price and defined period of time for managing the links from the computer

server.

15.   However, Kahn does disclose maintaining a listing of providers and prices (c23

L40-57), and it would have been obvious to one of ordinary skill in the art at the time the

invention was made to negotiate a contract with the providers before being entered as a

listing in the system, in order to maintain some data stability/consistency for system users.

16.   As per Claim 18, Kahn discloses wherein the second set of the human resource and the employee benefit products offered by the third party providers comprises one or more applications from the set consisting of: retirement plans including *401K*; unemployment insurance; Worker's compensation insurance; *group health insurance*; *dental insurance; group life insurance*; disability insurance; employee assistance; tax filing services; and child care services.

17.   As per Claim 19, Kahn discloses wherein the first set of human resource and the employee benefit products comprise: *payroll*; human resource compliance services; employee development tools and advisory services; discount procurement; purchasing cards; and work share and e-mail.

18.   As per Claim 20, Kahn discloses wherein the computer server provides a user interface to an authorized client user to modify the integrated benefits package, wherein the human resource and the employee benefit products from said first set and the human resource and the employee benefit products from said second set may be added and removed.

19.   As per **independent Claim 26**, Kahn discloses a network computer server that manages and administers a plurality of human resource and employee benefit products on a network, said plurality of products being implemented on a plurality of network computing devices, the server comprising: (a) a communication interface through which the server receives a user request to perform data operations on data sources of said plurality of products; and (b) a processor that conducts said data operations on the data

sources of each of the plurality of products; wherein said user views all of said plurality

of products as residing on a single computing device (Abstract, Fig.5, Figs.12(a)-15(e),

Figs. 26-34(b), C5 L1-12, C5 L51-61, C13 L43-57, C26 L32-36, C52 39-62).

20.   Kahn fails to expressly disclose wherein said processor determines triggering

events that require actions on said data sources of each of said plurality of products and

performs said actions in an integrated fashion.

21.   However, Kahn does the ability to update employee records (C27 L52-59), and

issuing system alerts to users (C52 L54-62).

22.   Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have included wherein said processor determines

triggering events that require actions on said data sources of each of said plurality of

products and performs said actions in an integrated fashion, in the system disclosed by

Kahn, for the advantage of providing a method of integrating a plurality of human

resource and employee benefit products, with the ability to increase system efficiency by

allowing users to modify profile information when appropriate.

23.   As per Claim 27, Kahn discloses wherein the network is the Internet.

24.   As per Claim 28, Kahn discloses wherein the processor responds to a user request

in accordance with a particular geographic location of the user residence.

25.   As per **independent Claims 29 and 36**, Kahn discloses a method of processing

operations in an integrated human resource management system over a computer

network, the method comprising: determining if additional new employee information is

needed to correctly change affected data records and, if so, then eliciting the additional

new employee information from a system user; updating the determined affected data

records in the data store with the new employee information such that the updated data

records are immediately available to computer network processes of the human resource

management system; and responding to a request from one of the computer network

processes by retrieving the updated data records from the data store (Abstract, Fig.5,

Figs.12(a)-15(e), Figs. 26-34(b), C5 L1-12, C5 L51-61, C13 L43-57, C26 L32-36, C52

39-62).

26.   Kahn fails to expressly disclose wherein said processor determines triggering

events that require actions on said data sources of each of said plurality of products and

performs said actions in an integrated fashion.

27.   However, Kahn does the ability to update employee records (C27 L52-59), and

issuing system alerts to users (C52 L54-62).

28.   Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have included wherein said processor determines

triggering events that require actions on said data sources of each of said plurality of

products and performs said actions in an integrated fashion, in the system disclosed by

Kahn, for the advantage of providing a method of integrating a plurality of human

resource and employee benefit products, with the ability to increase system efficiency by

allowing users to modify profile information when appropriate.

29.   As per Claims 30 and 37, Kahn discloses converting the retrieved updated data

records into a data format that is compatible with the requesting network process; and

providing the converted data records to the requesting network process.

30.   As per Claims 31 and 38, Kahn discloses wherein the requesting network

processes include applications that are installed at a host network server that receives the

requests, and includes application that are installed at third party network servers that receive data requests from the host network server.

31.   As per Claims 32 and 39, Kahn discloses wherein the employee information data store includes data record storage at the host network server and the data record storage located remotely from the host network server.

32.   As per Claims 33 and 40, Kahn discloses wherein the employee information data store includes data record storage at the third party network servers.

33.   As per Claims 34 and 41, Kahn discloses wherein the triggering event is an automatically generated event.

34.   As per Claims 35 and 42, Kahn discloses wherein the triggering event is an employee-entered change to one of the data records.

35.   As **per independent Claim 51**, Kahn discloses a user interface for displaying information directed to a specific employee, the information relating to employee administration products of an integrated package, the products including a third party provider product accessible over a network, comprising: at least one link associates with the third party provider product of the package; a first display area for displaying at least one recommendation relating to at least one employee administration product (drop down box of available providers) of the package responsive to receiving data (Abstract, Fig.5, Figs.12(a)-15(e), Figs. 26-34(b), C5 L1-12, C5 L51-61, C13 L43-57, C26 L32-36, C52 39-62).

36.   Kahn fails to expressly disclose receiving data indicating entry into a time period for a life event relating to the specific employee; and a second display area, separated

from the first display area by a boundary, for displaying at least one reminder for at least

one product of the package.

37.   However, Kahn does the ability to update employee records (C27 L52-59), and

issuing system alerts to users (C52 L54-62).

38.   Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have included receiving data indicating entry into a time

period for a life event relating to the specific employee; and a second display area,

separated from the first display area by a boundary, for displaying at least one reminder

for at least one product of the package, in the system disclosed by Kahn, for the

advantage of providing a method of integrating a plurality of human resource and

employee benefit products, with the ability to increase system efficiency by allowing

users to modify profile information when appropriate.

Conclusion

39.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

40.   The following non-patent literature is cited to show the best non-patent literature

prior art found by the examiner:

> **"Insurdata: Insurdata Introduces New Interactive Employee**
>
> **Benefits Management Software Solution," Business Wire, June**
>
> **8, 1998.**
>
> Insurdata discloses a system for managing employee Benefits with a
>
> life-even driven modification component.
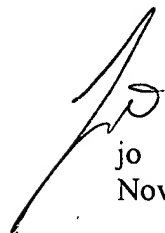
41.   Additional Literature has been referenced on the attached PTO-892 form, and the

Examiner suggests the applicant review these documents before submitting any
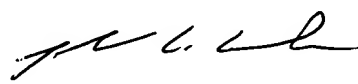
amendments.

42.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-

0662. The examiner can normally be reached on Monday through Thursday, 8am -

5:00pm.

43.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for

the organization where this application or proceeding is assigned (703) 872-9306 for all

official communications.

44.   Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 306-

5484.

jo
November 30, 2004

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600